

**REMARKS**

**I. Status of the Claims**

Claims 1-4, 8, and 11-13 are pending. By this Amendment, claims 1 and 8 have been amended.

**II. Claim Rejection Under 35 U.S.C. § 101**

In the Office Action, claim 8 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, it was asserted that the claims lack the "necessary physical articles or objects to constitute a machine or a manufacture" within the meaning of the statute.

By this Amendment, claim 8 has been amended to recite a "processing device," which comprises physical computer hardware to execute software components, as suggested in the Office Action. Thus, Applicants respectfully submit that the rejection has been overcome and should be withdrawn.

**III. Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, claims 1-4 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,905,777 to Foladare et al. in view of U.S. Patent No. 6,618,763 to Steinberg. Claims 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Steinberg and further in view of U.S. Patent No. 5,793,972 to Shane. As explained below, these rejections should be withdrawn.

**A. Claims 1-4 and 8 are patentable over Foladare in view of Steinberg**

According to M.P.E.P. § 2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974)), “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” Because Foladare and Steinberg fail to teach or suggest Applicants’ claimed combination recited in independent claims 1 and 8, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

Foladare teaches a “method and system for alerting a recipient when E-Mail arrives,” in which “E-Mail messages transmitted over an E-Mail network are routed to an E-Mail server servicing the recipient, where useful E-Mail messages can be identified, separated from the junk mail, and forwarded as directed by the recipient.” Foladare at col. 1, lines 14-15 and 43-46.

Further, in the system of Foladare, the “E-Mail server sends a summary of the E-Mail message to the recipient over a different network so that the recipient can select a forwarding destination for the message.” Id. at lines 47-50. Finally, the “recipient sends a selection signal to the E-mail server which then forwards the E-Mail message to the selected destination.” Id. at lines 50-52. According to Foladare, the “E-Mail message can be forwarded by the server over another network, such as the public telephone network, to a computer or a FAX machine at the recipient’s office, home or other destination.” Id. at lines 52-56.

Foladare fails to teach or suggest “compiling a database of a recipient’s scheduled location, a recipient’s delivery preference, and a corporation’s preference,” “receiving an updated scheduled location,” “locating the recipient in response to a user

inquiry to the system," "generating a merged preference set by merging the recipient's delivery preference and the corporation's preference," and "providing to the user the updated scheduled location," as recited in claim 1.

For example, Foladare provides no teaching or suggestion of "compiling a database of a recipient's scheduled location." Rather, the system of Foladare "alerts the recipient to the arrival of . . . messages to enable the recipient to designate to the server a selected forwarding destination to send the message." *Id.* at lines 61-64. (Emphasis added.) If the system of Foladare compiled a database of recipient's scheduled location, as claimed, there would be no need for the recipient to designate the forwarding destination each time a message was received. Rather, the system would designate the destination based on its compiled location database. Because the system of Foladare lacks a database of the recipient's scheduled location, the recipient must actively make such a selection.

Further, Foladare provides no teaching or suggestion of compiling a database of a "corporation's preference." Indeed, there is no mention in Foladare of any other entity providing its preferences, much less a corporation. Moreover, Applicants respectfully submit that a recipient selecting to forward an e-mail to a computer or fax machine at the recipient's office cannot reasonably be construed to comprise a "corporation's preference," as claimed.

Further, because Foladare fails to teach or suggest "compiling a database of a recipient's scheduled location," it necessarily fails to teach or suggest "receiving an updated scheduled location," as claimed.

Further, the system of Foladare provides no teaching or suggestion of "locating the recipient in response to a user inquiry to the system" because the system lacks a database of the recipient's scheduled location, as discussed above. Moreover, Foladare additionally lacks teaching or suggestion of any sort of "user inquiry," as claimed.

Further, Foladare lacks teaching or suggestion of "generating a merged preference set by merging the recipient's delivery preference and the corporation's preference," as claimed. As discussed above, Foladare lacks teaching or suggestion of a corporation's preference. Therefore, Foladare necessarily lacks teaching or suggestion of merging such a database with another database.

Finally, because Foladare lacks teaching or suggestion of any sort of "user inquiry," as discussed above, it necessarily lacks teaching or suggestion of "providing to the user the updated scheduled location," as claimed.

Regarding claim 8, Foladare fails to teach or suggest a "database containing a recipient's scheduled location, a recipient's delivery preference, and a corporation's preference," "a "processing device connected to the database for receiving an updated scheduled location and/or delivery preference for entry in the database," wherein the processing device is configured to "generate a merged preference set by merging the recipient's delivery preference and the corporation's preference," and to "provide to the user the recipient's updated scheduled location and the merged preference set to facilitate delivery of the message to the recipient at the updated scheduled location."

Steinberg teaches "unified messaging services which integrate voice messaging, email, and fax services into a single access point." Steinberg at col. 1, lines 56-58. A

"virtual private wireless network" according to Steinberg includes "at least one wireless device" and an "intelligent information interconnect device." Id. at lines 59-61. The "information interconnect device includes a centralized directory database storing identifying information regarding the wireless devices, and further storing delivery preference hierarchy information for delivering content to the wireless devices." Id. at col. 1, line 64 to col. 2, line 1.

However, Steinberg fails to overcome the deficiencies of Foladare discussed above. For example, Steinberg provides no teaching or suggestion of "compiling a database of a recipient's scheduled location, a recipient's delivery preference, and a corporation's preference," "receiving an updated scheduled location," "locating the recipient in response to a user inquiry to the system," "generating a merged preference set by merging the recipient's delivery preference and the corporation's preference," and "providing to the user the updated scheduled location," as recited in claim 1 or the corresponding elements recited in claim 8.

Because the combined teachings of the Foladare and Steinberg fail to teach or suggest Applicants' claimed combination recited in independent claims 1 and 8, as required by M.P.E.P. § 2143, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

**B. Shane fails to overcome the deficiencies of Foladare and Steinberg**

Shane, cited in the Office Action for its teaching of a mail generator that generates a multiplicity of direct mail pieces, is completely silent as to the above-described elements of claims 1 and 8. Thus, Shane fails to overcome the above-noted deficiencies of Foladare and Steinberg.

Because the combined teachings of Foladare, Steinberg, and Shane fail to teach or suggest Applicants' claimed combination recited in independent claims 1 and 8, as required by M.P.E.P. § 2143, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

Applicants respectfully submit that independent claims 1 and 8 are patentable over the references applied in the Office Action. Claims 2-4 and 11-13 depend directly or indirectly from claims 1 and 8 and therefore should be allowable for at least the same reasons the claims from which they depend are allowable.

**IV. Conclusion**

Applicants respectfully request that the Examiner reconsider this application, withdraw the claim rejections, and allow the pending claims in a timely manner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 16-1885.

Respectfully submitted,

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